

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 3627

J. CLARKE STEVENS et al.

Examiner: Buchanan, Christopher R.

Application No.: 09/396,612

Filed: September 15, 1999

For: METHOD AND SYSTEM FOR AUTOMATING
INVENTORY MANAGEMENT OF CONSUMER ITEMS

Attorney Docket No.: MEDO 5016 PUS (2003007574)

**REPLY BRIEF UNDER 37 C.F.R. § 41.41
TO EXAMINER'S ANSWER**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief in reply to the Examiner's Answer mailed March 6, 2008 for the above-identified patent application. The Examiner's Answer was in response to the Appellant's Appeal Brief filed October 6, 2006.

REPLY

Reply to (6) Grounds of Rejection to be Reviewed on Appeal

As indicated in section (6) of the Examiner's Answer, the sole ground of rejection to be reviewed on appeal is: claims 1-8 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,664,110 ("Green").

Reply to (9) Grounds of Rejection

A. Green

Regarding claim 1, the Examiner posited that Green discloses a method for automating the management of an inventory of consumer items (col. 13, lines 5-9) at a consumer location using a programmed device (DPU) accepting input data and executing instructions for automating inventory management (abstract), the method comprising:

- (a) receiving a series of shopping lists each including an item(s) (col. 7, lines 1-20, Fig. 3);
- (b) establishing a shopping list trend based on the shopping lists (col. 9, lines 38-41, frequently ordered items establishes a list trend, col. 12, lines 25-27, user buying patterns established);
- (c) generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list (col. 10, line 1+ , options list is the result of a suggested list (i.e., predicted) from the merchant or user);
- (d) receiving item price lists from corresponding shopping locations (col. 11, lines 24-34, there are multiple merchant databases (14, Fig. 2) thus multiple shopping locations); and

(e) recommending a shopping location based on the item price lists and the output list (col. 10, lines 30-41, interpreted that the system determines which of the merchants to order from and displays this on DPU, see Figs. 6-7).

B. Claim 1 Compared to Green

Step (b) of claim 1 provides for establishing a shopping list trend based on received shopping lists having items. As indicated above, the Examiner cited col. 9, lines 38-41 and col. 12, lines 25-27 for disclosing this limitation. Col. 9, lines 38-41 describe that "a list of frequently ordered [items]" is provided when an option list icon 64 of the DPU is activated. However, this provided list is not based on received shopping lists. Rather, this provided list is a "general list" which "can be the result of a suggested or typical shopping list provided by either the merchant during programming of the DPU 10 or by the supplier of the DPU 10" (col. 9, line 66 through col. 10, line 4). Col. 12, lines 23-27 describe that advertising provided to the DPU 10 "can be customized to the individual buying patterns of the user in question". However, as set forth in step (c) of claim 1, as indicated below, the established shopping list trend is used to generate an output list predictive of a next shopping list whereas the advertising is not used in such a manner.

In particular, step (c) provides for generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list. As indicated above, the Examiner cited col. 10, line 1+ for disclosing this limitation (options list is the result of a suggested list (i.e., predicted) from the merchant or user). With respect to the options list being from a merchant, again, the options list is "the result of a suggested or typical shopping list provided by either the merchant . . . or by the supplier of the DPU 10" (col. 9, line 66 through col. 10, line 4). As such, this "suggested or typical shopping list" is not generated in accordance with a shopping list trend based on received shopping lists such that the "suggested or typical shopping list" is predictive of a next shopping list as claimed. Rather, this "suggested or typical shopping list" is simply what its name says, i.e., "suggested

or typical". With respect to the options list being from a user, the options list is a result of the user creating "its own custom list to be displayed upon selection of the appropriate icon from an option list" (col. 10, lines 4-6). Such a custom list is a stored shopping list previously generated by the user. As such, the custom list is not generated in accordance with a shopping list trend based on received shopping lists such that the custom list is predictive of a next shopping list as claimed. In view of the foregoing, Green does not teach or suggest step (c) as claimed.

Step (e) of claim 1 provides for recommending a shopping location based on (i) item price lists, received from corresponding shopping locations, and (ii) the output list. As indicated above, the Examiner cited col. 10, lines 30-41 for disclosing this limitation (interpreted that the system determines which of the merchants to order from and displays this on DPU, see Figs. 6-7). The Appellant respectfully traverses as the user, as opposed to the system, is the entity that makes the determination as to which merchant to use for the user's order. In particular, col 10, lines 29-36 recite:

In the illustrated embodiment, to determine which of multiple merchants to order from and to determine the identity of the user, the DTFC 12 causes the DPU 10 to provide a prompt screen 76 on the DPU display 36, shown in FIG. 6, represented by step 244 of FIG. 13. Each user has at least one identification control card 80 for each merchant with which the user has a remote ordering account.

The prompt screen 76 on the DPU display 36 indicates that the system is waiting for the user to scan in an ID control card. Likewise, step 244 of FIG. 13 recites "Request User to Scan ID". As such, the user chooses which merchant to use for the user's order by scanning the ID card indicative of the user selected merchant. Therefore, Green does not teach or suggest step (e) as claimed.

Reply to (10) Response to Argument

The Examiner noted the Appellant's previous arguments that Green discloses neither (b) "establishing a shopping list trend" nor (c) "generating an output list in accordance with the shopping list trend". The Examiner responded that Green discloses these features and noted, in particular, col. 3, lines 45-63, and the references therein to items that are "regularly ordered" (lines 54-58), which regularly ordered items a user can conveniently "incorporate into an order list currently being constructed" (lines 52-53).

Again, steps (b) and (c) in conjunction provide for generating an output list in accordance with a shopping list trend, based on received shopping lists, such that the output list is predictive of a next shopping list. Col. 3, lines 45-63 describes custom reference lists of "regularly ordered" items. However, a custom reference list is not an output list predictive of a next shopping list as claimed. Rather, a custom reference list is simply a pre-stored template of popular items (such as certain perishables, office products, dairy products) that any user generally orders from a merchant when buying items from that merchant. Although, as posited by the Examiner, a user can "incorporate [a custom reference list] into an order list currently being constructed" to generate an "output list", this output list is not generated in accordance with a shopping list trend. Rather, this output list is generated by the user inputting the custom reference list into the output list in a manner analogous to how the user inputs items one at a time into the output list. The custom reference list simply provides the user with a short cut for inputting items into the output list.

The Examiner further indicated "that the features upon which the applicant relies (i.e., performing the method steps in an automated fashion by means of a machine) are not recited in the rejected claim(s)." In response, the Appellant notes that the features upon which the Appellant relies upon includes steps (a), (b), (c), (d), and (e) together with the preamble as recited in claim 1.

CONCLUSION

In view of the foregoing, the Appellant respectfully requests the Board to rule that claims 1-8 and 10 are patentable over Green.

Respectfully submitted,

J. CLARKE STEVENS et al.

By: 

James N. Kallis
Registration No. 41,102
Attorney for Applicant

Date: April 2, 2008

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351